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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/560,358
Filing Date: December 12, 2005
Appellant(s): SHIMIZU ET AL.

Ronald P. Kananen
Reg. No. 24,104
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6 January 2009 appealing from the Office action mailed 6 June 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0206203	Ly	11-2003
2003/0219226	Newell et al.	11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Ly (US 2003/0206203, filed 13 June 2002).

As per independent claim 1, Ly discloses an editing device for executing an editing process based on a list specifying edit details and registering an obtained edit result in an external device, comprising:

Processing means for performing a prescribed process on edit material (paragraph 0009: Here, the free form data is edited using the processing means)

Registration means for registering the editing result in the external device (paragraph 0075: Here, each of the data notes are stored within a data file)

Control means for controlling the processing means and the registration means, wherein:

The control means controls the processing means so as to perform the processes on only necessary parts out of the edit material and controls the registration means so as to register only a result of the process of the necessary parts in the external device as the editing material (paragraphs 0086-0089: Here, the control means routes the edit material to other users)

wherein the control means controls the processing means so as to perform the process on only necessary parts out of the edit material based on the list and controls the registration means so as to register only a result of the process of the necessary parts as the editing result in the external device when the list being created is reproduced according to external operation in a creation mode of the list (paragraphs 0086-0089: Here, the user edits are passed to the external collaborative editors).

wherein when a batch registration request of the editing result based on the list entered by external operation is given after the list is finished, the control means controls the processing means so as to perform the process has not been registered in the external device, out of the necessary parts out of the edit material, and controls the registration means so as to register a result of the process of the necessary parts in the external device as the editing results (paragraphs 0086-0089: Here, an option allows for approval of updates. In this instance, the batch of updates are held, and do not occur until a reviewer approves the updates)

when a sequential registration mode is set, and a sequential part registration request is received when the list is being created, said control means controls said processing means so as to perform the process and control said registration means so

as to register a sequential result of the process on only necessary parts that have not been registered in the external device (paragraphs 0086-0089: Here, in a sequential registration mode, the updates are pushed to users once received).

As per claim 4, the applicant discloses the limitations similar to those in claim 1. Claim 4 is similarly rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ly and further in view of Newell et al. (US 2003/0219226, filed 18 March 2003, hereafter Newell).

As per dependent claim 7, Ly discloses the limitations similar to those in claim 1. Ly fails to specifically disclose wherein the sequential part registration is prompted by a selection of a preview command. However, Newell discloses wherein the sequential part registration is prompted by a selection of a preview command (paragraph 0043: Here, the sequential preview is modified based upon the editing (deletion or update) of contents of the data storage system). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Newell with Ly, since it would have allowed a user to generate a preview sequence of data.

As per dependent claim 8, the applicant discloses the limitations substantially similar to those in claim 7. Claim 8 is similarly rejected.

(10) Response to Argument

With respect to claims 1 and 4, the appellant's initial argument is based upon the belief that the prior art fails to disclose an editing device for executing an editing process based on a list specifying edit details and registering obtained edit results in an external device (page 9). As an initial matter, it must be noted that this limitation appears in the appellant's claim preamble. Therefore, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the

intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The appellant further argues that the prior art fails to teach *wherein control means control processing means so as to perform the process on only necessary parts out of the edit material based on the list and controls said registration means so as to register only a result of the process of the necessary parts as the editing results in the external device when the list is being created is reproduced according to external operations in a creation mode of the list* (pages 9-10). The examiner respectfully disagrees. The examiner has previously stated, Ly discloses obtaining a change list. The change list being comprised of at least a single item, specifying details of an edit. The change list is propagated to other users of a document, in order to modify external documents to conform to the modified document, by recreating the edit operations contained within the list at an external device (paragraph 0089; see also: Advisory Action mailed 17 October 2008).

The appellant's assertion that the edit processes does not constitute a list (page 10) is incorrect. Ly discloses that the propagation of changes happens in near simultaneous fashion, with each edit pushed to clients from a server (paragraph 0089). Multiple edits performed within a single document would push multiple items, constituting a list of changes from the server to recipient clients, with each modification

specifying the extent of the modification (paragraphs 0088-0089). Therefore, the appellant's argument is not persuasive.

The appellant further argues that Ly fails to disclose batch registration modes, with the batch registration mode registering the edit result aft the list specifying edit details is finished (page 10). The examiner respectfully disagrees. Batch processing is commonly defined as the serial execution of items. The collaboration framework of Ly is a batch processing framework. Clients share modifications with other clients (paragraph 0089). Once a modification is made, the modification is propagated to other clients (paragraph 0089). Based upon acceptance, the propagated change is made (paragraph 0089). All changes within the collaboration environment of Ly serial changes, and require approval prior to becoming incorporated (paragraph 0089). Such a serial environment constitutes a batch processing environment. Additionally, even if the user has specified that data objects should be automatically updated (paragraph 0086), the serial nature of the updates remains a batch process, as each update is performed prior to performing any subsequent update. Therefore, this argument is not persuasive.

With respect to claims 7-8, the appellant argues that Newell fails to cure the perceived deficiencies of the rejection of claims 1 and 4 (page 12). However, the examiner has already addressed these perceived deficiencies, and this argument is similarly not persuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kyle Stork/

Kyle Stork

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